

Application Serial No. 10/032,032
Amendment dated March 21, 2006
Reply to Office Action dated February 3, 2006

REMARKS:**Status Of Claims**

Claims 1-23, 25, and 27-39 were previously pending. Claim 23 has been amended. Claim 39 has been canceled. Thus, claims 1-23, 25, and 27-38 are currently pending in the application with claims 1, 7, 14, 23, and 28 being independent.

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Applicant would like to thank the Examiner for indicating that claim 39 would be allowable if rewritten in independent form. The Examiner rejected claims 23, 25, and 27 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In this regard, claim 23 has been amended to include the limitations of claim 39.

In the Office Action, the Examiner also rejected claims 1-22 and 28-38 under 35 U.S.C. 103(a) as being unpatentable over Yokoyama, U.S. Patent No. 5,654,908. Applicant respectfully asserts that the currently pending claims distinguish the present invention over Yokoyama, and the other prior art references made of record, either alone or in combination.

Specifically, claim 1 recites "wherein the location is identified and the PDA address book entry is associated therewith within one portable hand-held device, thereby integrating PDA address book functions with Global Positioning System (GPS) capabilities in a single device". In contrast, as previously argued, Yokoyama simply does not teach these limitations. In fact, Yokoyama explicitly teaches an electronic diary 10, having some

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PDA functionality, being completely separate from a navigation apparatus 50, which provides GPS capabilities.

The Examiner argues that "[t]his combination of devices is considered obvious in light of the ability of technology to shrink electronics and provide more in a small space and cut down on communication costs". The Examiner also argues "that since old technology requires 2 devices because of space limitations that this does not teach away from advancement". However, such arguments ignore the explicit teachings of Yokoyama. Specifically, in column 3, Yokoyama teaches that "the diary 10 can be held in the hand" and "the navigation apparatus 50 is mounted in a motor vehicle". Furthermore, "[h]aving received the destination data, the navigation apparatus 50 establishes the intended route to the destination, ready for guiding the user M along the route when user M gets into the motor vehicle". Thus, Yokoyama explicitly teaches that his navigation apparatus 50 is to be mounted in the vehicle ready and waiting there for the user.

This configuration allows the user to send the destination data to the navigation apparatus 50 and let it calculate the route, while the diary 10 is free to handle other tasks. More specifically, as shown in Figure 8, upon receiving the destination data, the navigation apparatus 50 wakes up, determines where it is, determines the route to the destination, and then shuts itself down. As shown in Figure 9, upon the user starting the motor vehicle, the navigation apparatus 50 again wakes up and guides the user along the route. Thus, Yokoyama explicitly teaches a completely separate navigation apparatus 50 that is purposefully permanently mounted in the motor vehicle.

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This distribution of functionality is not required by space limitations, as suggested by the Examiner. Rather, as discussed above, Yokoyama teaches specific utility in his diary 10 being portable and travelling with the user. Yokoyama further teaches specific utility in his navigation apparatus 50 operating within his vehicle, separately and independently from his diary 10. Furthermore, Yokoyama is devoid of any suggestion of space limitations. Thus, "the ability of technology to shrink electronics and provide more in a small space and cut down on communication costs" would not motivate any modification of Yokoyama.

Rather, the Examiner's reference to "the ability of technology to shrink electronics and provide more in a small space and cut down on communication costs" would only support making Yokoyama's diary 10 and navigation apparatus 50 smaller and cheaper. Such an ability of technology does not suggest combining devices previously explicitly taught to be distinctly separate. Such an inference, if permissible, would completely eliminate the burden the courts have placed on the Examiner, in interpreting 35 U.S.C. § 103(a).

Specifically, as previously noted, the Examiner must satisfy three criteria in order to establish the requisite *prima facie* case of obviousness: (1) there must be some suggestion or motivation to modify the reference or combine their teachings; (2) there must be a reasonable expectation of success; and (3) the combination of references must teach or suggest all the claim limitations. MPEP §706.02(j), citing *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991).

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In meeting this initial burden to establish *prima facie* obviousness of a claimed invention, as stated in MPEP §2143.03, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970). Furthermore, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); see also *In re Gordon*, 221 USPQ2d 1125, 1127 (Fed. Cir. 1984).

In the present case, the Examiner acknowledges that "Yokoyama lacks that the GPS capabilities are within the PDA device". Furthermore, Yokoyama simply does not teach or even suggest "wherein the location is identified and the PDA address book entry is associated therewith within one portable hand-held device", as claimed in claim 1. Therefore, the Examiner failed to cite a reference that either teaches this limitation or provides the requisite motivation or suggestion for modifying Yokoyama to include the limitations of claim 1. Rather, as previously argued, Yokoyama explicitly teaches separation of such functionality, thereby explicitly teaching away from the claimed invention. Therefore, Yokoyama simply cannot provide the requisite motivation. Nor can the Examiner's reference to an "ability of technology" provide the requisite motivation.

Finally, the Examiner asserts that "[t]he claims have still failed to define that the address book information can be obtained from another device and stored in the PDA".

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While this is somewhat unclear, Applicant would like to point out that claim 1 recites **"wherein the location is identified and the PDA address book entry is associated therewith within one portable hand-held device**, thereby integrating PDA address book functions with Global Positioning System (GPS) capabilities in a single device", emphasis added. Therefore, claim 1 requires that the identification and association occur "within one portable hand-held device". In contrast, the prior art all requires multiple devices to identify and associate a location with a PDA address book entry. Thus, claim 1 recites limitations not disclosed or suggested by the prior art. As a result, the Examiner has failed to properly establish a *prima facie* case of obviousness, and the present obviousness rejections simply cannot be sustained.

Claim 2 recites "wherein identifying a location includes identifying a location based on electronic map data". Claim 3 recites "wherein identifying a location includes identifying a location based on a GPS-determined current location". Claim 4 recites "wherein identifying a location includes identifying a location based on electronic map data and a cursor position on the electronic map". Claim 5 recites "identifying electronic map feature data associated with the location" and "pre-filling the PDA address book entry using the electronic map feature data associated with the location". Thus, these claims require some form of associating a PDA address book entry with a location identified based on electronic map data and/or GPS capabilities. Such limitations, when combined with the limitations of claim 1, explicitly require **the single device to have both PDA address book functionality and mapping and/or GPS capabilities**. Such limitations, when combined

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with the limitations of claim 1, further explicitly require **the location be identified using those mapping and/or GPS capabilities.**

In contrast, Yokoyama's user identifies the location using his diary 10. The diary 10 has absolutely no mapping or GPS capabilities. Rather, Yokoyama explicitly teaches the diary 10 pushing the destination data to his navigation apparatus 50 which provides some mapping and GPS capabilities. Furthermore, as previously argued, information from Yokoyama's diary 10 is pushed to his navigation apparatus 50, not the other way around. Therefore, Yokoyama's user is never given the opportunity to identify a location based on electronic map data or GPS capabilities. As a result, Yokoyama simply does not disclose, suggest, or make obvious the limitations of the currently pending claims.

Claim 7 recites "**wherein the location is associated with the PDA address book entry within one portable hand-held device**, thereby integrating PDA address book functions with Global Positioning System (GPS) capabilities in a single device", emphasis added. In contrast, as discussed above, Yokoyama fails to teach such integration. In fact, as discussed above, Yokoyama explicitly teaches away from such integration, and therefore cannot provide the requisite motivation. Thus, the Examiner has failed to the Examiner has failed to properly establish a *prima facie* case of obviousness, and the present obviousness rejections cannot be sustained.

Claim 13 recites "wherein associating a location with the PDA address book entry to form a waypoint includes associating a user-selectable symbol with the waypoint". Claim 22 recites "wherein the computer-executable instructions are further adapted to associate

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a user-selectable symbol with the location". In contrast, none of the prior art references made of record allows the user to select the symbol to be used. Rather, the prior art dictates the symbol to be used. As a result, Yokoyama simply does not disclose, suggest, or make obvious the limitations of the currently pending claims. Furthermore, **the Examiner fails to even assert that the prior art discloses or suggests this limitation.**

Claim 14 recites "[a] computer-readable medium having computer-executable instructions adapted to associate a Personal Digital Assistant (PDA) address book entry with a location on *an electronic map that is capable of being displayed on the PDA*", emphasis added. In contrast, as discussed above, Yokoyama's electronic diary 10 simply cannot display any map. Rather Yokoyama requires his navigation apparatus 50 to display any maps. However, the navigation apparatus 50 does not provide any PDA functionality, and therefore cannot be analogous to a PDA. As a result, Yokoyama simply does not disclose, suggest, or make obvious "an electronic map that is capable of being displayed on the PDA", as claimed in claim 14.

Claim 15 recites "wherein the computer-executable instructions are further adapted to identify the location based on a GPS-determined current location and then to create the PDA address book entry to be associated with the identified location to form a waypoint".

Claim 16 recites "wherein the computer-executable instructions are further adapted to identify the location based on a cursor position on the electronic map and then to create the PDA address book entry to be associated with the identified location to form a waypoint". Claim 17 recites "wherein the location is associated with electronic map feature

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data, and wherein the computer-executable instructions are further adapted to pre-fill the PDA address book entry using the electronic map feature data associated with the location". These claims each recite some form of creating a PDA address book entry using electronic map data.

In contrast, Yokoyama simply doesn't work that way. As discussed above, information from Yokoyama's electronic diary 10 is pushed to his navigation apparatus 50, not the other way around. Simply put, Yokoyama's navigation apparatus 50 does not provide the electronic diary 10 any electronic map data that could be used in creating a PDA address book entry. As a result, Yokoyama simply does not disclose, suggest, or make obvious the limitations of the currently pending claims.

Claim 19 recites "wherein the computer-executable instructions are further adapted to create the PDA address book entry, and then associate a location with the PDA address book entry to form a waypoint". Claim 20 recites "wherein the computer-executable instructions are further adapted to display the waypoint on the electronic map". Claim 21 recites "wherein the computer-executable instructions are further adapted to provide route guidance to the waypoint". Thus, these claims explicitly require **the same set of computer instructions that associates "a Personal Digital Assistant (PDA) address book entry with a location on an electronic map that is capable of being displayed on the PDA"**, as claimed in claim 14, **to also form, display, and/or route to the waypoint**. As discussed above, Yokoyama requires multiple components to provide this functionality. Thus,

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Yokoyama fails to disclose, suggest, or make obvious the limitations of the currently pending claims.

Claim 28 recites "[a] Personal Digital Assistant (PDA) device with an integrated electronic map and address book" and ***"wherein the device is adapted to associate a location that is capable of being displayed on the electronic map with a PDA address book entry to form a waypoint"***, emphasis added. Claim 30 recites "wherein the device is adapted to pre-fill data fields in the PDA address book entry with electronic map data associated with the location". Claim 32 recites "wherein the device is adapted to create the PDA address book entry, and then identify the location associated with the PDA address book entry". Claim 33 recites "wherein the device is adapted to route to the waypoint on the electronic map". Claim 35 recites "a Global Positioning System (GPS) receiver integral to the PDA". Claim 36 recites "wherein the location associated with the PDA address book entry is determined by a GPS-determined location of the GPS receiver". Claim 37 recites "wherein the location associated with the PDA address book entry is determined by a cursor position on the electronic map".

In contrast, as discussed above, Yokoyama requires his navigation apparatus 50 to provide mapping capabilities, which his electronic diary 10 cannot provide. Simply put, as previously argued, Yokoyama fails to disclose integration of the claimed functionality, such as GPS capabilities, routing capabilities, map data manipulation, and associating locations with address book entries, into one device. Furthermore, neither Yokoyama nor the Examiner's reference to an "ability of technology" can provide the requisite motivation

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for modifying Yokoyama to include such functionality into one device. As a result, Yokoyama simply fails to disclose, suggest, or make obvious the limitations of the currently pending claims.

The remaining claims all depend from claims 1, 7, 14, 23, or 28, and are therefore also allowable.

Any additional fee which is due in connection with this amendment should be applied against our Deposit Account No. 501-791. In view of the foregoing, a Notice of Allowance appears to be in order and such is courteously solicited.

Respectfully submitted,

By:



David L. Terrell, Reg. No. 50,576
Garmin International, Inc.
1200 East 151st Street
Olathe, KS 66062
(913) 397-8200
(913) 397-9079 (Fax)